

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. This response is believed to fully address all issues raised in the outstanding Office Action mailed May 19, 2005. Furthermore, no new matter is believed to have been introduced hereby.

Claims 1, 6, 15, and 24 have been amended as detailed above. Hence, claims 1-27 remain pending.

Figures

The outstanding Office Action objects to the figures for failure to show a printed report (as detailed in item “1.” of the Office Action starting on page 2). In response, Figure 6 has been added. Support for Figure 6 may be found at various locations in the specification, such as the last sentence of the first full paragraph on page 15. Furthermore, the specification has been amended as detailed above to make typographical changes as well as to indicate the inclusion of Figure 6.

Figure 4 has been objected to for failure to show the reference number “400” (as detailed in item “2.” of the Office Action starting on page 2). In response, a replacement sheet that includes the amended Figure 4 has been provided herewith.

No new matter is believed to have been introduced hereby. Accordingly, the objection to the figures is now moot.

Obviousness Rejections

Claims 1-27 stand rejected under 35 U.S.C. §103(a) over U.S. Publication No. 2001/0017701 to Ito (hereinafter “the ‘701 publication”) and variously in combination with U.S. Publication No. 2002/0110073 to Shu (hereinafter “the ‘073 publication”), U.S. Patent No. 6452874 to Otsuka (hereinafter “the ‘874 patent”), and/or U.S. Patent No. 6865431 to Hirota (hereinafter “the ‘431 patent”). Each of these rejections is fully addressed below.

Unsupported Rejections

Claims 11, 13, 17, 19, 20, and 22

The outstanding Office Action rejects some of the claims (for example, claims 11, 13, 17, 19, 20, 21, or 22) in view of allegedly well-known art, inherency (or impliedly), or otherwise effectively takes “Official Notice” of certain matters. It is respectfully submitted that the outstanding Office Action fails to establish a *prima facie* case of obviousness by improperly relying on common knowledge to reject claims 11, 13, 17, 19, 20, 21, or 22.

In particular, M.P.E.P. §2143 sets forth three basic criteria for a *prima facie* case of obviousness. The outstanding Office Action at least fails to meet the third criterion with respect to rejecting claims 11, 13, 17, 19, 20, 21, or 22. For example, the Office Action fails to meet the requirement that “the prior art reference (or references when combined) must teach or suggest all the claim

limitations” by improperly relying on common knowledge. See, M.P.E.P. §2143.

Also, pursuant to M.P.E.P. §2144.03, applicant hereby traverses these rejection and kindly requests the Examiner to provide a reference in support of the assertions recited in the outstanding Office Action, or to otherwise withdraw the rejection.

With respect to inherency, applicant asserts that the record fails to provide any factual support for a finding of teaching by inherency. To prove inherency, the Examiner must establish that the disclosure(s) of the cited art necessarily include the limitation(s) recited in rejected claims. Continental Can Co. U.S.A. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). There is no such showing on the record.

For example, with respect to claim 11, the Office Action states that:

... (in order to print the identified filename and capacity information, **the file must be accessed** to retrieve the identifying data
... [Emphasis Added]

Is the Office suggesting that this is “necessarily” the only way filename and capacity information can be obtained? Hence, these rejections should be withdrawn, or otherwise specifically clarified if another Office Action is to be mailed.

Also, the rejection of other claims (for example, claims 13, 17, 19, 20, 21, or 22) appears to be cursory, without reciting specific support. Other

examples include but are not limited to the Office's failure to recite support for rejecting claims 13, 17, 19, e.g., when the Office respectively asserts that the cited art impliedly includes or must have tag information, an indication (flag or field), matching content ID [key] at a server, require a saved telephone number, or that a URL locator. Again, the Office fails to support that the cited art "necessarily" includes the limitations recited in the rejected claims.

Furthermore, pursuant to M.P.E.P. §2144, if the Examiner is basing the grounds for rejection on the Examiner's personal knowledge, applicant hereby kindly calls upon the Examiner to set forth the facts in an Examiner's affidavit or to otherwise withdraw the rejection. Moreover, when a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. M.P.E.P. §2144.03; 37 C.F.R. §1.104(d)(2).

Claims 4 and 9

The outstanding Office Action rejects some of the claims (for example, claims 4 and 9) without citing any support for the rejections. M.P.E.P. §2143 sets forth three basic criteria for a *prima facie* case of obviousness. The outstanding Office Action fails to at least meet the third criterion with respect to rejecting claims 4 and 9. In particular, the Office Action fails to meet the requirement that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See, M.P.E.P. §2143.

With respect to claims, 4 and 9, the Office fails to indicate where “WMA” is taught by the cited references. If another Office Action is to be mailed in this matter, applicant respectfully requests the Office to indicate where this limitation is taught by the cited references, or otherwise withdraw this rejection.

Accordingly, the rejection of claims 4, 9, 11, 13, 17, 19, 20, 21, and 22 is moot for at least the above reasons. Also, claims 12-14 and 20-23 depend from claims 11 and 19, and should be allowable for at least similar reasons as their respective independent claims, as well as additional or alternative elements that are recited therein but not shown in the cited prior art.

CLAIMS 1-10, 15-18, AND 24-27

Without limiting the scope of the invention, to expedite the prosecution of the present application and to make typographical changes and in an effort to impart precision to the claims (e.g., by more particularly pointing out various embodiments, rather than to avoid prior art), independent claims 1, 6, 15, and 24 have been amended as detailed above.

As amended, claims 1, 6, 15, and 24 in part recite reading or printing “content type” data. It is respectfully submitted that none of the cited references, alone or in combination, appear to teach, disclose, or suggest the claimed combination of features such as set forth in the amended claims 1, 6, 15, and 24. Accordingly, claims 1, 6, 15, and 24 are in condition for allowance.

More particularly, the outstanding Office Action relies on the ‘701 publication for rejection of claims 1, 6, 15, and 24. To support this rejection, the Office Action indicates that Fig. 7 of the ‘701 publication teaches that some data may be printed on a removable media. As the Office Action indicates, this data appears to be merely limited to the filename and the capacity information. As discussed with respect to the unsupported rejection of claim 11 above, the Office fails to establish that either the filename or the capacity information would necessarily have to be obtained from a file. Also, the cited references fail to teach, disclose, or suggest that the recitation of “content type.” Accordingly, claims 1, 6, 15, and 24 are in condition for allowance.

Claims 2-5, 7-10, 16-18, and 25-27 depend from claims 1, 6, 15, and 24, and should be allowable for at least similar reasons as their respective independent claims, as well as additional or alternative elements that are recited therein but not shown in the cited prior art.

Conclusion

Reconsideration and allowance of all claims is respectfully requested.

The Examiner is urged to telephone the undersigned if that would expedite prosecution of the application.

Respectfully Submitted,

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By His Representatives,

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Dated: June 21, 2005

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In the Figures

Figure 4 has been amended by adding reference number “400” and a replacement Figure 4 has been provided herewith.

Please add Figure 6 that is provided herewith.